

REMARKS

Applicant respectfully requests further examination and reconsideration in view of the instant response. Claims 1-27 remain pending in the case. Claims 1-27 are rejected. Claim 10 is amended herein. No new matter is added as a result of the claim amendments.

35 U.S.C. §101

The Office Action mailed May 2, 2007, states that Claims 1-27 are rejected under 35 U.S.C. §101 as it is asserted that "the claimed invention is directed to non-statutory subject matter.

Applicant respectfully notes that no grounds for rejecting Claims 1-9 and 19-27 under 35 U.S.C. §101 are provided in the Office Action. Moreover, Applicant respectfully submits that Claims 1-9 and 19-27 are directed toward statutory subject matter, and thus overcome the rejection under 35 U.S.C. §101.

Furthermore, Applicant has amended Claim 10 to recite, in part, "[a] computer useable medium stored thereon a computer program directed to cause a computer to execute a method comprising". Applicant respectfully submits that Claim 10 is directed toward statutory subject matter, and thus overcomes the rejection under 35 U.S.C. §101. Moreover, Applicant respectfully submits that Claims 11-18, dependent on Claim 10, also overcomes the rejection under 35 U.S.C. §101.

35 U.S.C. §103(a)

Claims 1-5, 10-14 and 19-23

Claims 1-5, 10-14 and 19-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,999,512 by Yoo et al., hereinafter referred to as the "Yoo" reference, in view of U.S. Patent No. 6,404,814 by Apostolopoulos et al., hereinafter referred to as the "Apostolopoulos" reference. Applicant has reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 1-5, 10-14 and 19-23 are patentable over Yoo in view of Apostolopoulos for at least the following rationale.

"To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" (emphasis added; MPEP 2142). In particular, "[i]t is improper to combine references where the references teach away from their combination" (emphasis added; MPEP 2145(X)(D)(2). Applicant respectfully notes that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI)).

First, Applicant respectfully submits that there is no suggestion or motivation to modify Yoo in the manner suggest in the Office Action mailed May 2, 2007. Furthermore, Applicant respectfully submits that Yoo teaches away from the suggested modification.

In the Office Action mailed May 2, 2007, it is asserted that Yoo discloses "performing a multi-stage service on said streaming media (Yoo: Fig. 4, data is parsed in multiple stages: sequence header, GOP header, picture header,

etc.); and caching an intermediate result from one of the stages of said multi-stage process (Yoo: Fig. 3, intermediate data from the transcoding process is temporarily stored in MEM1 (element 308) and MEM2 (element 334))" (see Office Action mailed May 2, 2007, at page 4, lines 5-10). Applicant respectfully submits that the rejection is based on a combination of embodiments of Yoo. Moreover, Applicant respectfully asserts that the relied upon embodiments, illustrated in Figures 3 and 4 of Yoo, are mutually exclusive, and that there is no teaching or suggestion to modify either of the embodiments in the manner suggested in the Office Action.

With reference to Figure 3 of Yoo, a closed loop transcoder is shown (col. 4, lines 40-42). "The apparatus of FIG. 3 reconstructs entire video data from a MPEG-1 bitstream and re-encodes the video data to have a desired aspect ratio and bit rate" (col. 5, lines 3-5). In particular, Applicant understands the apparatus of FIG. 3 of Yoo to re-encode an MPEG-1 bitstream into an output MPEG-1 bitstream with a converted bit rate.

In contrast, "FIG. 4 [of Yoo] is a diagram illustrating the processes of a transcoding method according to the present invention, through which a MPEG-1 bitstream is converted into a MPEG-4 bitstream" (emphasis added; col. 6, lines 4-8).

Applicant respectfully submits that re-encoding an MPEG-1 bitstream into an output MPEG-1 bitstream, as shown in Figure 3 of Yoo, is a completely different operation than converting and MPEG-1 bitstream into an MPEG-4 bitstream, as shown in Figure 4 of Yoo. Furthermore, Applicant respectfully submits that these operations are mutually exclusive, and that there is no suggestion or motivation to modify either embodiment in the manner suggested. As specifically recited in Yoo, "the transcoders of FIGS. 2 and 3

perform a conversion between the same encoding methods so that they cannot be applied to MPEG-4 terminals which are essential to a variety of multimedia communications and storage relating to Internet videos, mobile networks, smart media and the like” (col. 5, lines 38-43).

In particular, Applicant respectfully submits that there is no teaching, suggestion or motivation within Yoo to modify either of the embodiments of Figures 3 or 4 in the manner suggested in the current Office Action. Moreover, by specifically teaching that the transcoder of Figure 3 “cannot be applied to MPEG-4 terminals”, Yoo teaches away from such a modification and combination of embodiments.

Second, Applicant respectfully submits that modifying one of the embodiments illustrated in Figures 3 and 4 of Yoo in the manner suggested would render Yoo unsatisfactory for its intended purpose. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphasis added; MPEP 2143.01). In particular, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification” (emphasis added; MPEP 2143.01 (V)).

As described above, Applicant respectfully submits that Figure 3 of Yoo illustrates a transcoder for re-encoding an MPEG-1 bitstream into an output MPEG-1 bitstream, and that Figure 4 of Yoo illustrates converting an MPEG-1 bitstream into an MPEG-4 bitstream, as shown in Figure 4 of Yoo. Moreover, Applicant understands Yoo to specifically disclose that performing a conversion between the same encoding methods “cannot be applied to MPEG-4 terminals” (col. 5, lines 38-43).

Applicant respectfully submits that the intended purpose of the transcoder of Figure 3 is to re-encode an MPEG-1 bitstream into an output MPEG-1 bitstream with a different bit rate (col. 5, lines 3-5). In particular, Applicant respectfully submit that modifying the transcoder of Figure 3 to convert an MPEG-1 bitstream to an MPEG-4 bitstream would render the transcoder unsatisfactory for its intended purpose of performing a conversion between the same encoding method.

Moreover, Applicant respectfully submits that the intended purpose of the process of Figure 4 is to convert and MPEG-1 bitstream into an MPEG-4 bitstream (col. 6, lines 4-8). In particular, Applicant respectfully submit that modifying the process of Figure 4 re-encode an MPEG-1 bitstream into an output MPEG-1 bitstream with a different bit rate would render the process unsatisfactory for its intended purpose of performing a conversion to a different encoding method.

Applicant respectfully submits that the combination of Yoo and Apostolopoulos does not render the claimed embodiments unpatentable, because Apostolopoulos does not overcome the shortcomings of Yoo. Applicant understands Apostolopoulos to disclose transcoding a predictively-coded object-based picture signal to a predictively-coded block-based picture signal. Applicant respectfully submits that Apostolopoulos does not suggest or provide motivation for modifying Yoo in the manner suggested in the Office Action mailed May 2, 2007.

Applicant respectfully asserts that the combination of Yoo and Apostolopoulos does not satisfy a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Therefore, Applicant respectfully asserts that the combination

of Yoo and Apostolopoulos does not teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1, 10 and 19, that these claims overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance. Therefore, Applicant respectfully submits that the combination of Yoo and Apostolopoulos also does not teach or suggest the additional claimed features of the present invention as recited in Claims 2-5 that depend from independent Claim 1, Claims 11-14 that depend from independent Claim 10, and Claims 20-23 that depend from independent Claim 19. Therefore, Applicant respectfully submits that Claims 2-5, 11-14 and 20-23 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

Claims 6-9, 15-18 and 24-27

Claims 6-9, 15-18 and 24-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yoo in view of Apostolopoulos, further in view of U.S. Patent No. 6,647,061 by Panusopone et al., hereinafter referred to as the "Panusopone" reference. Applicant has reviewed the cited references and respectfully submits that the embodiments of the present invention as recited in Claims 6-9, 15-18 and 24-27 are patentable over Yoo in view of Apostolopoulos, further in view of Panusopone for at least the following rationale.

Claims 6-9 depend from independent Claim 1, Claims 15-18 depend from independent Claim 10, and Claims 24-27 depend from independent Claim 19. Hence, by demonstrating that the cited references do not show or suggest the limitations of Claims 1, 10 and 19, it is also demonstrated that the cited references do not show or suggest the limitations of Claims 6-9, 15-18 and 24-27.

As recited above in the discussion of the rejection of Claims 1-5, 10-14 and 19-23, Applicant respectfully submits that the combination of Yoo and Apostolopoulos does not satisfy a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Moreover, Applicant respectfully submits that the combination of Yoo, Apostolopoulos and Panusopone does not render the claimed embodiments unpatentable, because Panusopone does not overcome the shortcomings of the combination of Yoo and Apostolopoulos. Applicant understands Panusopone to disclose video size conversion and transcoding from MPEG-2 to MPEG-4. Applicant respectfully submits that Panusopone does not suggest or provide motivation for modifying Yoo in the manner suggested in the Office Action mailed May 2, 2007.

Applicant respectfully asserts that the combination of Yoo, Apostolopoulos and Panusopone does not satisfy a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Therefore, Applicant respectfully asserts that the combination of Yoo, Apostolopoulos and Panusopone does not teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1, 10 and 19, that these claims overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance. Therefore, Applicant respectfully submits that the combination of Yoo and Apostolopoulos also does not teach or suggest the additional claimed features of the present invention as recited in Claims 6-9 that depend from independent Claim 1, Claims 15-18 that depend from independent Claim 10, and Claims 24-27 that depend from independent Claim 19. Therefore, Applicant respectfully submits that Claims 6-9, 15-18 and 24-27

also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

CONCLUSION

In light of the above remarks, Applicant respectfully requests reconsideration of the rejected claims. Based on the arguments presented above, Applicant respectfully asserts that Claims 1-27 overcome the rejections of record and, therefore, Applicant respectfully solicits allowance of these claims.

The Examiner is invited to contact Applicant's undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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